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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,205	06/26/2001	David G. Turek	2437/103	9328

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/892,205	Applicant(s) Turek et al.	
	Examiner O'Connor	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 13, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5-43, and 57 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-43, and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on January 7, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on January 13, 2005 in reply to the previous Office action, mailed October 8, 2004.
2. The amendment of claims 1, 5, 6, 10, 11, 14-21, 23, 30, 32, 34-43, and 57, and cancellation of claims 3 and 4 by applicant, in the reply filed January 13, 2005, are hereby acknowledged.

Claim Objections

3. Claim 57 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph), or, in other words, that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

When, as here, an independent claim recites a particular method, a dependent claim drawn to an apparatus capable of performing the method of the independent claim is not a proper dependent claim if the apparatus might be used in other ways, since the dependent claim (the

apparatus) could conceivably be infringed without infringing the basic claim (the method), in violation of the infringement test for proper dependency of claims. See MPEP § 608.01(n)(III).

Applicant is required to cancel the claim, amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 2, 5-22, 30-43, and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrington (US 5,895,454).

Harrington discloses a method of establishing a customized electronic site 20 for the purposes of providing products 30, the method comprising: (a) obtaining over a network

information specifying criteria 32 associated with the customized electronic site 20, wherein the criteria include a selection of products 30 and descriptions; and, (b) using the information to automatically establish a customized electronic site 20, including automatically establishing a database 10 containing the specified criteria 32.

Regarding claim 2, the method of Harrington includes that the information is obtained by a primary electronic site 21.

Regarding claim 5, in the method of Harrington, automatically establishing a customized electronic site includes automatically establishing a database containing format preferences for the customized electronic site (see, for example, column 5, lines 14-21).

Regarding claim 6, in the method of Harrington, the primary electronic site includes a first selection/purchase engine.

Regarding claim 7, in the method of Harrington, establishing a customized electronic site includes replicating the first selection/purchase engine for use by the customized electronic site.

Regarding claim 8, in the method of Harrington, establishing a customized electronic site includes enabling the customized electronic site to use the first selection/purchase engine.

Regarding claim 9, in the method of Harrington, establishing a customized electronic site includes providing a second selection/purchase engine for use by the customized electronic site.

Regarding claims 10 and 11, the method of Harrington further comprises: (a) obtaining a set of user ratings of the selection of products and descriptions over the network; (b) analyzing

the set of user ratings through a primary electronic site; and, (c) automatically suggesting products that confirm to a user's preferences (see, for example, column 5, lines 25-47).

Regarding claims 12-13, in the method of Harrington, the analysis is performed with a preference analysis methodology using a collaborative filtering process.

Regarding claim 14, in the method of Harrington, the network is the Internet.

Regarding claims 15 and 16, in the method of Harrington, the customized electronic site can either be part of, or separate from, a "primary" electronic site.

Regarding claims 17-20, in the method of Harrington, the criteria include a selection of either pre-specified goods descriptions or pre-specified services descriptions.

Regarding claims 21 and 22, in the method of Harrington, obtaining information includes providing over a network a template that elicits user-specified data, which template includes a web page.

Regarding claims 30 and 31, in the method of Harrington, the criteria include a selection of pre-specified marketing materials that are transmitted across the network, wherein the marketing materials includes advertisements.

Regarding claims 32-34, in the method of Harrington, the criteria include a selection of links that are transmitted across the network, wherein the selection of links includes data ports and/or information pertinent to the products.

Regarding claim 35, in the method of Harrington, the criteria include a selection of linkages between the customized electronic site and a primary electronic site.

Regarding claim 36, in the method of Harrington, the criteria include a selection of linkages between the customized electronic site and resources pertinent to the customized electronic site.

Regarding claim 37, in the method of Harrington, the primary electronic site provides the selection of goods and effects delivery of the goods to a user in bulk.

Regarding claims 38, 39, 42, and 43, in the method of Harrington, the primary electronic site provides the selection of goods and/or services, and effects delivery of the goods and/or performance of the services individually to a user.

Regarding claims 40 and 41, in the method of Harrington, the selection of goods and/or services are inventoried by the primary electronic site (inherently listed/contained/indexed in the database).

Regarding claim 57, the method of Harrington is implemented by means of a computer program product.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington (US 5,895,454).

Harrington discloses a method of establishing a customized electronic site 20 for the purposes of providing products 30, as applied above in the rejection of claim 1 under 35 U.S.C. 102(b), but the method of Harrington does not include that the customized electronic site pertains to customized goods and the criteria includes customization data pertinent to customizing the goods, wherein the customization data includes a logo transmitted via any of electronic upload, facsimile, e-mail, electronic download, or regular mail. However, websites that pertain to customized goods and criteria that includes customization data pertinent to customizing the goods, wherein the customization data includes a logo transmitted via any of electronic upload, facsimile, e-mail, electronic download, or regular mail are well known, hence obvious, to those of ordinary skill in the art, and official notice to that effect is hereby taken. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Harrington so as to have the customized electronic site pertain to customized goods and the criteria include customization data pertinent to customizing the goods, wherein the customization data includes a logo transmitted via any of electronic upload, facsimile, e-mail, electronic download, or regular mail, as is well known to do, in order to adapt/apply the system to a business selling customized goods that wanted to begin a presence on the Internet, and since so doing could be performed readily and easily, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

8. Applicant's arguments filed Jan. 13, 2005 have been fully considered but are not persuasive.

9. Regarding the argument that the website of Harrington "merely offers a link to a distinct pre-existing web site that offers products," the website of Harrington does far more than "merely" offer a link to a pre-existing website. For example, the website of Harrington "transmits purchase/ordering data to the remote vendor sites corresponding to the users selection" (abstract, lines 26-27).

10. Regarding the arguments concerning a "user" connecting to the database of Harrington, the "user" in the method of Harrington is the end customer to whom the "vendors" sell their "products." The functionality of Harrington which anticipates applicant's invention concerns the "vendors" establishing their websites at the electronic site of Harrington.

11. Regarding the argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that "automatically" means "only and entirely by machine without human aid or intervention") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Regarding the argument that a vendor may choose to have it website created by the database administrator of Harrington, a vendor may indeed choose to have it website created by the database administrator of Harrington (that is, automatically--independent of any further action or activity by the vendor).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(571) 272-6788**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

April 18, 2005

 4/18/05

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